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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,320	08/16/2001	Paul Charles Downey	12000-901	3960

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Barley, Snyder, Senft & Cohen, LLC
126 East King Street
Lancaster, PA 17602-2893

EXAMINER

GLESSNER, BRIAN E

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,320

Applicant(s)

DOWNEY, PAUL CHARLES

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8-16, 19-27 and 29-31 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

The following office action is in response to the amendment filed on May 14, 2004 and the RCE filed on August 26, 2004. Claims 1-16 and 18-31 are pending in the application. Claims 8-16, 19-27 and 29-31 are rejected and claim 28 is withdrawn from consideration as being drawn to a non-elected invention, claims 1-7 are allowed, and claim 18 is objected to as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 102

Claims 8-11, 13-16, 19, 21-23, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kakimoto et al. (6,602,586).

In regard to claims 8 and 13, Kakimoto discloses a substrate for use in a flooring system that has a sub-floor and a decorative upper layer, the substrate consisting of a continuous sheet 1 having a bottom surface, a top surface, side surfaces and end surfaces, the top surface and the oppositely facing bottom surfaces are essentially parallel (column 5, lines 53-57, i.e. square or rectangular) to each other and are spaced apart by a thickness of the substrate, the thickness of the substrate being about 10 mm (column 4, lines 2-6, i.e. 15 mm is about 10 mm, the layer 2 is a minimum of 10 mm and the layer 3 is a minimum of 5 mm. The two layers form the sheet 1), voids are provided in the substrate, the voids are provided between particles of rubber (column 5, lines 20-24) such that when the substrate is positioned between the sub-floor and the decorative top layer, the particles of rubber provide the strength required to prevent deformation of the substrate in the direction of the thickness and the voids contribute to the sound dampening characteristics required to provide decibel reduction across the thickness of

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the substrate (column 6, lines 42-53). Kakimoto also discloses that the sheet contains an adhesive 53 located on the bottom surface for fixing the substrate to the sub-floor. Finally, although Kakimoto does not specifically disclose that said bottom surface is "configured" for frictional interface with the sub-floor, and the top surface is "configured" for receiving the decorative upper layer, the examiner would like to point out that these limitations are functional limitations. Therefore, since Kakimoto's sheet meets the structural limitations of the claim, it is inherent that his sheet will also be capable of functioning in the same manner as applicant's sheet. Therefore, the claimed limitations are met.

In regard to claims 9 and 15, Kakimoto discloses the claimed invention, wherein the density of the substrate 2 is less than 1000 kilograms per meter cubed (column 5, lines 25-27). In regard to claims 10 and 16, Kakimoto discloses the claimed invention, wherein the substrate has the strength characteristics required to support the decorative top layer while having sufficient resiliency to allow the substrate to be delivered in rolls. Although Kakimoto does not specifically show or state the substrate could be rolled into rolls, he does disclose that the substrate has the same structural limitations as the applicant's substrate. Therefore, since the two substrates have the same structural limitations, they will inherently function in the same manner. Thus, it is inherent that Kakimoto's substrate could be rolled into rolls.

In regard to claims 11 and 19, Kakimoto discloses the claimed invention, wherein the substrate is made from an SBR rubber material (column 5, lines 32-33).

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In regard to claim 14, Kakimoto discloses the claimed invention, wherein the continuous sheet is cut to the appropriate length to fit the space requirements.

In regard to claim 17, Kakimoto discloses the claimed invention, wherein the substrate is fixed to the sub-floor by means of an adhesive (column 6, lines 6-16).

In regard to claim 21, Kakimoto discloses a substrate for use in a flooring system that has a sub-floor and a decorative upper layer, the substrate comprising all the limitations of the claim. Claim 21 contains the same limitations set forth in claims 8 and 9. Therefore, claim 21 is rejected on the same grounds of rejection set forth above with respect to claims 8 and 9.

In regard to claim 22, Kakimoto discloses the claimed invention, wherein the substrate has the strength characteristics required to support the decorative top layer while having sufficient resiliency to allow the substrate to be delivered in rolls. Although Kakimoto does not specifically show or state the substrate could be rolled into rolls, he does disclose that the substrate has the same structural limitations as the applicant's substrate. Therefore, since the two substrates have the same structural limitations, they will inherently function in the same manner. Thus, it is inherent that Kakimoto's substrate could be rolled into rolls.

In regard to claim 23, Kakimoto discloses the claimed invention, wherein the substrate is made from an SBR rubber material (column 5, lines 32-33).

In regard to claims 26 and 27, Kakimoto discloses the claimed invention, wherein the rubber sheet is a desired length. Kakimoto does not specifically disclose that said rubber is cut from a cylindrical member. However, this claim limitation is a process

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limitation. Therefore, even though process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Therefore, since the final product is a rubber sheet, the claimed limitations are met because Kakimoto discloses the use of a rubber sheet.

Claims 12, 20, 24, 25 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakimoto et al. (6,602,586).

In regard to claims 12, 20, 24, 29 and 31, Kakimoto discloses the claimed invention except for specifically disclosing that the sound dampening characteristics exhibit a decibel reduction of approximately 20 dB for a substrate with a thickness of 5 mm, or that said density is less than 700 kg/m^3 . It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Kakimoto's substrate have a decibel reduction of 20 dB for a substrate of 5 mm, and to make the density less than 700 kg/m^3 , since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. The examiner takes the position that since the applicant's structure and Kakimoto's structure are the same, they will obviously be capable of performing the same functions. Further, Kakimoto even discloses that the density is 700 kg/m^3 , column 5, lines 25-30. Therefore, to make the density 699 kg/m^3 would have been obvious to one having ordinary skill in the art at the time the

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invention was made because 699 kg/m^3 and 700 kg/m^3 are essentially the same to one having ordinary skill.

In regard to claim 25, Kakimoto discloses the claimed invention except for specifically disclosing that said rubber is formed in a cylindrical member and the sheets are cut from the cylindrical member. However, this claim limitation is a process limitation. Therefore, even though process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Therefore, since the final product is a rubber sheet, the claimed limitations are met because Kakimoto discloses the use of a rubber sheet.

In regard to claim 30, Kakimoto discloses the claimed invention, wherein said substrate includes a binder and particles of rubber. Kakimoto does not specifically disclose that said binder and particles of rubber are severed at the top and bottom surface of the sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to cut or sever the sheets so that they would fit into the area they are to be installed into. For example, if one were placing the sheets on the floor of a room having walls, one would have to cut or sever at least some of the sheets so that they would fit within the walls of the room. Therefore, the rubber particles and binder would be severed at the top and bottom surfaces. Finally, the rubber particles are already severed before they are made into the sheet because Kakimoto discloses that

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said particles are from used tires. Thus, the tires would have to be chopped up to form the particles.

Allowable Subject Matter

Claims 1-7 are allowed.

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 18 would be allowable because there is no proper motivation to place an adhesive on the top surface of Kakimoto's sheet, because Kakimoto's sheet is the finished layer for a floor or road surface.

Response to Arguments

Applicant's arguments filed May 14, 2004 have been fully considered but they are not persuasive.

The examiner would like begin by stating that he did not say in the interview held on May 10, 2004 that the claims would be allowable if amended to include the "consisting of" limitation. The examiner said that the consisting of limitation appeared to overcome the rejection of Kakimoto. However, upon further review, the examiner does not believe that to be true.

The applicant argues that Kakimoto discloses the use of two layers 2 and 3 and, therefore, does not disclose a single sheet. The examiner respectfully disagrees. Kakimoto does disclose a single sheet. However, the single sheet is made of two layers. Therefore, since Kakimoto does disclose the claimed limitations, the claims are rejected in view of the Kakimoto reference.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031. The examiner can normally be reached on Monday through Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian E. Glessner
Primary Examiner
Art Unit 3635

B.G.
November 2, 2004